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PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841			JACOBSON, MICHELE LYNN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,477	Applicant(s) FOEGLER ET AL.
	Examiner MICHELE JACOBSON	Art Unit 1782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 August 2010.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-4, 6-16, 18-20 and 22-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-4, 6-16, 18-20 and 22-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/10 has been entered.

Examiner Notes

2. Any objections and/or rejections made in the previous action, and not repeated below, are hereby withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2, 3, 12-14, 16 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. Claims 2 and 12 have been amended to recite that "the coating consists of" at least one edible binder; solid aroma substances and/or liquid aroma substances, dyes and/or flavorings and optional crosslinker, citrate or smoke treatment. There is no support in applicant's specification for a coating that "consists" of only these elements. Page 3, lines 32-35 cited by applicant in the remarks filed 8/12/10 only discloses that the coating is "made of edible material which contains solid and/or liquid aroma substances, dyes and/or flavorings". Page 4, line 36-Page 5, line 3 only discloses that the coating may comprise crosslinkers. The examples in applicant's specification disclose coatings made of gelatin and spice. There is no recitation in applicant's specification of a coating "consisting" of only edible binder, aroma substances, dyes and/or flavorings and crosslinker and therefore, there is no support to exclude further elements from this layer by using the recitation that it consists of only the elements recited in claims 2 and 12. As such, the amendments to claims 2 and 12 to recite that the coating "consists" of only the elements recited constitutes new matter. Claims 3, 13, 14 and 16 depend from claims 2 and 12 and therefore incorporate the new matter

limitations of claims 2 and 12. As such, claims 3, 13, 14 and 16 are also rejected for reciting new matter.

6. Claim 23 has been amended to recite the limitation of a layer "consisting of an essentially water-soluble material". There is no support in applicant's specification for a layer that "consists" of only an essentially water-soluble material. The recitation from applicant's specification cited on page 7 of the remarks filed 8/12/10 explicitly discloses that the layer claimed in claim 23 "**comprises** water soluble material" not that it *consists* of water soluble material. Therefore, there is no support to exclude further elements from this layer by using the recitation that it consists of "an essentially water-soluble material". Claim 24 depends from claim 23 and therefore incorporates the new matter limitations of claim 23. As such, claim 24 is also rejected for reciting new matter.

7. Claim 25 recites "a coating weight ranging from 33 g/m² to 59 g/m²". This range is not supported by applicant's specification as filed. While the specification filed by applicant included individual data points of coating weight of 33 g/m² and 59 g/m², there is no recitation in the specification of any *range* of coating weights. Therefore, the newly claimed range is not supported. See for example *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), the ranges described in the original specification included a range of "25%- 60%" and specific examples of "36%" and "50%." A corresponding new claim limitation to "at least 35%" did not meet the description requirement because the phrase "at least" had no upper limit and caused the claim to read literally on embodiments outside the "25% to 60%" range, however a limitation to "between 35% and 60%" did meet the description requirement. In the instant case, no range was

originally disclosed, therefore, individual examples cannot be used to provide end points for a range. Claim 26 depends from claim 25 and therefore incorporates the new matter limitations of claim 25. As such, claim 26 is also rejected for reciting new matter.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4, 6-16, 18-20 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 recites the limitation "wherein the coating (i) is not water soluble or is only slightly water soluble". It is unclear from this recitation what level of water solubility is tolerable for a coating to be considered "only slightly water soluble". Therefore, one of ordinary skill in the art would not be reasonably apprised of the full scope and breadth of the invention claimed. Claims 2-4, 6-16, 18-20 and 25 and 26 are rejected for being dependent from indefinite claim 1. Appropriate clarification is required.

11. Claims 2 and 12 have been amended to recite that "the coating consists of" at least one edible binder; solid aroma substances and/or liquid aroma substances, dyes and/or flavorings and optional crosslinker, citrate or smoke treatment. The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of

materials other than those recited except for impurities ordinarily associated therewith.") (MPEP 2111.03) In the instant case is unclear what is being excluded from the claim because the elements that are present in the invention are not specified in the claim. The recitation of "at least one edible binder" does not explicitly specify how many binders are present. The recitation in claim 2 of "solid aroma substances and/or liquid aroma substances, dyes and/or flavorings" fails to specify which of these elements are actually present. The recitation in claim 12 of "at least one aroma substance, dye and/or flavoring" does not explicitly specify how many or which of these elements are present. The recitation in claims 2 and 12 of "optional crosslinker, citrate or smoke treatment" does not explicitly specify whether these materials are even present, let alone which of them are present or how many of these are present. Because of these deficiencies it is unclear what elements are actually excluded from the claim because it is unclear what elements are actually present in the coating or mixture claimed in claims 2 and 12 respectively. Claims 3, 13, 14 and 16 are rejected as being dependent from indefinite claims 2 and 12. Appropriate clarification is required.

12. Claim 13 recites that the mixture of claim 12 is "an aqueous mixture". A claim which depends from a claim which "consists of" the recited elements or steps cannot add an element or step.(MPEP 2111.03) In the instant case, claim 13 adds the element of water to the mixture claimed in claim 12 since claim 13 specifies that the mixture is aqueous. Appropriate correction is required.

13. Claims 23 and 26 recite the limitation of "a layer consisting of (made of) an essentially water-soluble material". It is unclear from this recitation how soluble a

material has to be in order to be considered "essentially water-soluble". Therefore, one of ordinary skill in the art would not be reasonably apprised of the full scope and breadth of the invention claimed. Claim 24 is rejected for being dependent from indefinite claim 23. Appropriate correction is required.

14. Claim 23 also recites the limitation "so that the transferable coating loses its anchoring under the action of moisture". There is insufficient antecedent basis for this limitation in the claim. The coating in claim 23 is not recited to have "anchoring". This recitation is furthermore indefinite because the coating is not recited to be anchored to anything and therefore it unclear how the coating could "lose its anchoring". Claim 24 is rejected for being dependent from indefinite claim 23. Appropriate correction is required.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4, 6-16, 18-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. European Patent Application Publication No. 408164

(hereafter referred to as Ito) and Barnmore et al. U.S. Patent Application Publication No. 2001/0008658 (hereafter referred to as Barnmore).

17. Ito teaches a water-resistant matrix web with a food flavoring material disposed on it comprising food flavoring material dispersed on a binder material. (Pg. 2, lines 27-30) The water resistant matrix web is recited to be comprised of natural or artificial fiber materials such as polymers of cellulose and other natural materials (viscose, acetate, etc), polyester, polyamide, polyethylene, polypropylene and viscose coated Manilla paper. (Pg. 2, lines 37-44, 56) Webs produced from such natural or artificial fibers are interpreted by the examiner to read on the textile and consolidated nonwoven support layers recited in claim 1 since the web is made out of fibers which is the definition of a textile and is nonwoven as recited.

18. The food layer is recited to include herbs, pepper, cheese powder and powders of vegetable extracts. (Pg. 3, lines 8-17) The binder layer for the flavoring material is recited to be comprised of polysaccharides such as starch, modified starch, carboxymethylcellulose and protein such as gelatin. (Pg. 3, lines 22-28) The selection of these materials is recited to result in the food layer being neatly transferred onto the surface of the food disposed in a casing made of such a laminate.

19. The laminate is produced by applying a solution of the binder layer material to the matrix web followed by applying the food layer material in a powdery, granular or chip form onto the coated web and drying the thus formed sheet material. The formed sheet may then be formed into a tube for use as a sausage casing by heat sealing the film or by joining the edges of a non-heat-sealable film with the aid of an adhesive tape.

(Pg. 3, lines 33-42) When the sheet is brought into contact with a web substrate food, the food material is transferred from the matrix to the substrate food, thus effectively flavoring or spicing the food. (Pg. 4, lines 7-9)

20. Ito is silent regarding the transfer layer being transferred completely onto a foodstuff, the textile support further comprising a barrier layer and a water soluble layer between the textile support and the transfer layer.

21. Barmore teaches a packaging film comprising a first thermoplastic layer which can be coated with a second edible film layer which is transferred to a product during cooking comprising a binder, an additive and a crosslinking agent. (Para. 8, 11) The film is adhered to the meat product such that upon removing the film from the meat product, the edible film layer remains adhered to the meat product. (Para. 33) The binder and the crosslinking agent provide cohesion of the coating. (Para. 196)

Additionally, the nature of the binder along with the crosslinking agent is believed to control the rate of hydration of the coating allowing the coating to remain intact against the flow of high moisture meat product. (Para. 196)

22. The additive may comprise caramel, natural colorant, spice or citrate. (Para. 12) The binder may comprise a first binder including alginate, methyl cellulose and hydroxypropyl starch and a second binder comprising materials including albumin, zein, carageenan, casein, soy protein or wheat protein. (Para. 16)

23. The packaging film preferably further comprises a third layer between the first and second layer comprising the materials such as alginate and hydroxypropyl starch to serve as a release layer. (Para. 23) The packaging film of the invention is also recited

to comprise a layer which serves as a barrier to oxygen. (Para. 28) The laminate of the invention is recited to be useful for production of casings such as fin-sealed, lap-sealed and butt-sealed casings for meat products. (Col. 32)

24. Both Ito and Barmore are directed towards laminate films for transferring edible films to packaged meat products comprising polysaccharides and proteins. One of ordinary skill in the art would have been motivated to substitute the coating material recited by Barmore for the coating material disclosed in Ito because of the cohesion provided to the coating by the crosslinking agent disclosed in the coating of Barmore.

25. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the flavor transfer layer of Barmore for the flavor transfer layer disclosed in Ito. This substitution would have yielded the predictable result of producing a textile support based sausage casing comprising an edible flavor transfer layer with better properties of cohesion than that of the film recited by Ito by virtue of the crosslinker. "In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395.

26. The obvious substitution of the coating disclosed by Barmore consisting of edible binder, flavoring and crosslinking agent for the transfer coating recited by Ito would have produced the same invention as claimed in claims 1-4, 6, 7, 10, 11, 15, 16, 18 and 19 produced by the method recited in claims 12, 13 and 20.

27. Regarding claims 8, 9 and 14: Barmore clearly discloses utilizing an oxygen barrier layer for the food packaging film recited. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included an oxygen barrier layer in the laminate disclosed by Ito to prevent degradation of the packaged food by oxygen. Since the barrier layer would obviously not be transferred to the packaged food, one of ordinary skill would have provided it on the support layer recited by Ito prior to coating the support with the transfer layer. This obvious utilization of a barrier layer would have produced the invention claimed in claims 8 and 9 produced by the method claimed in claim 14.

28. Regarding claim 22: Both Ito and Barmore recite binder materials comprising starch and protein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the collagen or gelatin binder recited by Ito with crosslinking agent in order to produce a more cohesive coating and to control the rate of hydration of the coating allowing the coating to remain intact against the flow of high moisture meat product. Each of these benefits is explicitly recited by Barmore to be provided by the disposition of crosslinking agent in binder material. The advantageous disposition of crosslinking agent in the binder of Ito would have also produced a coating that was not water soluble or was only slightly water soluble.

29. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made given the combined teachings of Ito and Barmore to have used gelatin or collagen for the protein based binder material disclosed by Barmore since these materials were disclosed in Ito to be useful binders. The selection

of a known material based on its suitability for its intended use supports a *prima facie* obviousness determination. ("Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious)) (MPEP 2144.07) This obvious substitution of known elements would have yielded the same invention claimed in claim 22.

30. Regarding claims 23 and 24: Barmore clearly recites employing a third layer between the edible layer and thermoplastic layer. This third layer of Barmore is not disclosed to include crosslinking agent and would therefore be water soluble since it is disclosed to comprise water soluble materials such as alginate and hydroxypropyl starch. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included this third layer when employing the edible film recited by Barmore since it is disclosed by Barmore to be useful. The obvious use of the embodiment of Barmore comprising this third layer in the casing of Ito would have produced the same invention claimed in claims 23 and 24.

31. Regarding claims 25 and 26: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied result effective variable of coating weight depending on the amount of coating that was desired to be placed on the meat product. This optimization would have produced a casing with the same coating weight as claimed in claim 25. The flavorings disclosed by Ito are interpreted to

be in coarse-grained or piece form and their obvious inclusion in the coating of Barmore reads on the invention claimed in claim 25. The inclusion of a water soluble third layer as claimed in claim 26 has been addressed above in the rejection of claim 23.

Response to Arguments

32. Applicant's arguments filed 8/12/10 have been fully considered but they are not persuasive.
33. Applicant asserts on page 8 of the remarks that the range recited in claim 25 is supported because "the inventive coatings may be applied via doctor blade application, which is well known in the art to apply coatings having the recited weight range". However, the bar for new matter does not rely upon what was well known in the art at the time the invention was made and instead relies upon applicant's explicit disclosure. Coating weight is not an inherent property of the method of coating used and therefore applicant's assertions are not found persuasive.
34. Applicant's further assertion that it is not necessary to "describe exactly the subject matter claimed" and that it is "unnecessary to spell out every detail of the invention in the specification" is also not found persuasive since the case cited for the first assertion ignores the second half of the sentence cited which states "the description **must clearly** allow persons of ordinary skill in the art to **recognize** that Gosteli invented

what is claimed. *Wertheim*, 541 F.2d at 262, 191 USPQ at 96" and the case cited for the second assertion only applies to claims originally submitted, not amended claims.

35. Applicant asserts on page 12 of the remarks that Ito and Barmore are not analogous art. However, both Ito and Barmore are directed towards laminate films for transferring edible films to packaged meat products comprising polysaccharides and proteins. Therefore, contrary to applicant's assertion that the casings disclosed are "intended for different end uses", the casing of Ito and Barmore are clearly intended for the same use. Applicant's assertions regarding the differences between polymeric and fabric films are nullified by the fact that both polymeric and fabric films are clearly disclosed in the teachings of Ito and Barmore to have adhesion to polysaccharide and protein based coatings.

36. Applicant's assertion on page 12 that the modification of Ito with Barmore would "have clearly required the incorporation of plasticizer to impart flexibility" is not accurate. Barmore discloses several embodiments of the coating recited, the only requirements being as recited in paragraph 11 of Barmore that the coating comprise a flavoring, a binder and a crosslinking agent. Any assertion by applicant throughout the remarks that Barmore *requires* plasticizer is **inaccurate** since this material is clearly disclosed to be optional.

37. Applicant's assertion on page 12 that it was unexpected that a coating that is not water-soluble could be formed in the absence of plasticizer is clearly proven inaccurate by the disclosure in Barmore of transferable coatings that do not comprise plasticizer.

38. Applicant asserts on page 13 of the remarks that Ito "requires a water soluble size layer". Although Ito discloses that the transfer layer may be water soluble, it does not destroy the function of Ito to substitute the water insoluble transfer layer of Barmore for the transfer layer of Ito since both layers are edible and perform the same function.

39. Applicant's assertions on pages 13 and 14 regarding the additional third layer disclosed by Barmore are addressed in the rejection above and not found persuasive. The layer disclosed by Barmore comprising uncrosslinked alginate and hydroxypropyl starch would function in the same manner as the layer claimed in claims 23 and 26 and therefore obviates the invention claimed.

40. Applicant's assertions regarding coating weight do not negate the obvious optimization of the result effective variable of coating weight explained above. Additionally, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding any inherent coating weights in the prior art must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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